

CERTIFICATE OF MAILING

I hereby certify that this paper and every paper referred to therein as being enclosed is being deposited with the U.S. Postal Service as first class mail, postage prepaid, in an envelope addressed to: Commissioner of Patents & Trademarks, Washington, DC 20231,

on Apr 30, 1997 (Date of Deposit)

Date

Name



#12/C  
S/D  
5/25/97

1173/1C044-USD

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

PAUL O. ZAMORA and BUCK A. RHODES

Serial No.: 08/454,949

Art Unit: 1211

Filed: May 31, 1995

Examiner: D. Jones

For: PEPTIDE-METAL ION PHARMACEUTICAL PREPARATION

April 30, 1997

Hon. Commissioner of Patents  
and Trademarks  
Washington, D.C. 20231

Sir:

AMENDMENT

In response to the Office Action issued on December 30, 1996, please  
amend the above-identified application as follows.

### **PRIORITY DATE OF THE APPLICATION**

The Examiner states that the February 20, 1992 filing date of the parent application Serial No. 07/840,077 is the proper priority date for this application, rather than August 8, 1990, the filing date of the grandparent application Serial No. 07/565,275, now U.S. Patent 5,102,990. The Examiner maintains that '077 is the earliest copending application to disclose the subject matter of the present application.

Applicants respectfully disagree. For example, the '990 patent discloses term "antibody fragments" which a person of ordinary skill in the art would interpret as including both peptide and polypeptide fragments of antibodies. Therefore, it is believed that the '990 patent adequately supports a priority claim for the present application.

### **PROVISIONAL REJECTION UNDER OBVIOUSNESS-TYPE DOUBLE PATENTING**

In the previous Office Action, claims 1-16 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 of co-pending application serial number 08/484,184. In the present Office Action, the Examiner states that the double patenting rejection of claims 1-16 over Serial No. 08/484,184, filed June 7, 1995, is being maintained, but would be overcome by filing a Terminal Disclaimer.

This provisional rejection is rendered moot by the cancellation of claims 1-16 herein.

Claims 1-16 and 74-88 are provisionally rejected under the judicially-created doctrine of double-patenting in view of co-pending applications Serial Nos. 07/998,820, 08/087,219, 08/269,929, 08/461,305, and 08/484,184. Claims 1-16 and 74-88 are also rejected under the judicially-created doctrine of double patenting in view of issued U.S. Patent No. 5,556,609. However, the Examiner concedes that the above-noted Terminal Disclaimer will also overcome the new double-patenting rejection.

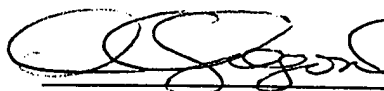
In response, the rejections of claims 1-16 are moot in view of the cancellation of claims 1-16. ~~With respect to the remaining pending claims, applicants re-~~

Applicants: PAUL O. ZAMORA and BUCK A. RHODES  
Serial No.: 08/454,949  
Filed: May 31, 1995  
Page 9

~~U.S.C. §102(a) in view of Fischman should be withdrawn.~~

In view of the amendments and remarks made herein, it is respectfully submitted that, but for the submission of a Terminal Disclaimer, the pending claims are in allowable condition. Accordingly, applicants respectfully request an indication of allowability of the pending claims.

Respectfully submitted,



Adda C. Gogoris  
Registration No. 29,714  
Attorney for Applicants

DARBY & DARBY, P.C.  
805 Third Avenue  
New York, N.Y. 10022  
Phone (212) 527-7700

M:\1173\1C044\ADJO458.W52